

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Palo Alto Networks, Inc.,
Fortinet, Inc. and
WatchGuard Technologies, Inc.
Petitioners,

v.

Selective Signals, LLC
Patent Owner

IPR2018-00594
PATENT 8,111,629

**PATENT OWNER'S MOTION TO AMEND
PURSUANT TO 37 C.F.R. § 42.121**

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EX1001	U.S. Patent No. 8,111,629 (“the ’629 Patent”)
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I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d)(1) and 37 C.F.R. § 42.121(a), Patent Owner (“PO”) Selective Signals, LLC files this contingent Motion to Amend to conditionally replace certain claims of U.S. Patent No. 8,111,629 (“the ’629 Patent,” EX1001) as described. Pursuant to 37 C.F.R. § 42.121(a), prior to filing this Motion to Amend, Patent Owner conferred with the Board in a conference call held on November 2, 2018.

This Motion to Amend is contingent on the conclusion of the Patent Trial & Appeal Board (“Board”) that a preponderance of the evidence establishes that any of Claims 15 and/or 17–22 are unpatentable. This motion includes, in an appendix attached hereto, a claim listing including a clean version of substitute Claim 25–29 and a marked-up version of substitute Claims 25–29 showing amendments with respect to Claims 17–18 and 20–22 respectively.

Only one substitute claim of the set of claims (Claims 25–29) is proposed to replace each of a subset of the challenged claims (Claims 17–18, and 20–22, respectively), and thus this motion presents a presumptively reasonable number of substitute claims in accordance with 37 C.F.R. § 42.121(a)(3). Challenged Claims 15 and 19 have not been amended. Pursuant to 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii), substitute Claims 25–29 do not enlarge the scope of Claims 17–18 and 20–22 or introduce new matter as explained in Sections II–III. Substitute

Claims 25–29 incorporate limitations that further distinguish over the references upon which this Inter Partes Review was instituted. Therefore, this motion is responsive to all grounds of unpatentability involved in this proceeding, as explained in Sections II–III.¹ Table 1 below maps the extant dependent claims to the proffered substitute claims.

TABLE 1

Original Claim	Substitute Claim
17	25
18	26
20	27
21	28
22	29

Patent Owner respectfully requests the Board to grant this Motion to Amend should it find that a preponderance of the evidence establishes that any of Claims 15 and/or 17–22 are unpatentable.

¹ Pursuant to 37 C.F.R. § 42.121(b)(2), PO reserves the right to later demonstrate support in earlier-filed disclosures responsive to issues raised in opposition to this motion.

II. Independent Claims

A. Substitute Independent Claims

Reproduced below (from the attached appendix) is the modified version of proposed Claim 25, offered to amend and replace dependent Claim 17, which has been narrowed and rewritten in independent form. The amendments in underline indicate amendments that have been added to rewrite the claim in independent form. The amendments in **bold underline** indicate amendments that have been added to narrow the extant claim.

25 (Amended Claim 17). [[The method of claim 15]] A method of identifying session type, comprising:
obtaining passing packets of respectively unknown sessions and unknown session types;
obtaining traffic packet characteristics of said passing packets of respectively unknown session types;
comparing said obtained packets with each other using respectively obtained traffic packet characteristics;
grouping together those packets having similar values of said traffic packet characteristics into a presumed session;
analyzing said grouped packets of said presumed session for session characteristics; and
using said session characteristics to identify a session type of said presumed session,

wherein the traffic packet characteristics comprise parameters associated with a traffic packet, the parameters including more than packet header information, and

wherein said identifying a session type is followed by at least one of the group comprising: providing provisioning and providing control actions to the **presumed** session.

B. The Substitute Claims Do Not Enlarge the Scope of the Original Claims

Substitute Claims 25–29 do not enlarge the scope of original Claims 17–18 and/or 20–22. Narrowing features have been added to dependent Claim 17, which has been rewritten into independent form. In particular, substitute independent Claim 25 has been amended to recite that “the traffic packet characteristics comprise parameters associated with a traffic packet, the parameters including more than packet header information.” This amendment narrows the scope of Claim 17, and no aspect of Claim 17 is broadened.

C. The Substitute Claims Do Not Introduce New Matter

The ’629 Patent was issued on February 7, 2012, from U.S. Pat. App. No. 12/513,510 (“the ’510 Application”), a national stage entry of PCT App. No. PCT/IL2007/001336, filed on Nov. 1, 2007, which claims priority to U.S. Provisional Pat. App. No. 60/856,795, filed on Nov. 6, 2006. As demonstrated below, the substitute Claim 25 is supported by the originally filed disclosure of the ’629 Patent. Pursuant to 37 C.F.R. §§ 42.121(b)(1), 42.121(b)(2), support for the

substitute claims is identified below with reference to the originally filed '510 Application.²

The limitation of substitute Claim 25 “wherein the traffic packet characteristics comprise parameters associated with a traffic packet, the parameters including more than packet header information” is supported in the specification of the '510 Application (and also *See* PCT/IL2007/001336 and WO2008/056349) at least in the following locations: page 2, lines 12–17; page 5, lines 15–16; page 5, line 27 to page 6, line 27; page 8, line 29 to page 9, line 6; page 9, lines 22–30; page 10, lines 25–26; and page 11, lines 16–28. The limitation of substitute Claim 25 “wherein the traffic packet characteristics comprise parameters associated with a traffic packet, the parameters including more than packet header information” is supported in the specification of U.S. Pat. Provisional App. No. 60/856,795 at least at pages 2–3.

D. Response to All Grounds of Unpatentability

As detailed above, substitute independent Claim 25 recites a narrowing limitation: “traffic packet characteristics that comprise parameters associated with a traffic packet, the parameters including more than packet header information.”

The addition of this feature further distinguishes substitute Claim 25 as patentable

² References in this motion are to the page and line numbers of the '510 Application.

over the references forming the bases of this IPR, whether taken alone or in combination. Specifically, as detailed in PO's Response to the Petition, both *Pappu* and *Peleg* describe using ***header-only data*** for traffic management. Neither *Pappu* nor *Peleg* disclose *wherein the traffic packet characteristics comprise parameters associated with a traffic packet, the parameters including more than packet header information*. Accordingly, Petitioners have failed to make a prima facie case of obviousness against substitute independent Claim 25 with respect to any of Petitioners' cited references. Thus, Claim 25 is allowable.

III. Dependent Claims

A. Substitute Dependent Claims

The '629 Patent includes six challenged dependent claims: Claims 17–22. This Motion to Amend includes adding substitute dependent Claims 26–29, substituting for challenged dependent Claims 18 and 20–22, respectively. The substitute dependent claims include clarifying amendments, such as changes to dependency information. The attached appendix includes the modified versions of proposed Claims 26–29, offered to amend Claims 18 and 20–22, respectively.

B. The Substitute Claims Do Not Enlarge the Scope of the Original Claims

Substitute Claims 26–29 do not enlarge the scope of original Claims 18 and/or 20–22. As dependent claims, Claims 26–29 fall within the broader scope of substitute independent Claim 25. As detailed above, Claim 25 does not enlarge the

scope of challenged Claim 17. Therefore, Claims 26–29 do not enlarge the scope of the challenged claims.

C. The Substitute Claims Do Not Introduce New Matter

Substitute Claims 26–29 amend challenged Claims 18 and 20–22, respectively. The claim amendments alter dependency information and other informalities. As such, substitute Claims 26–29 do not introduce new matter. To the extent that the amendments represent any change to the subject matter of prior Claims 18 and/or 20–22, support may be found in the '510 Application (and also *See* PCT/IL2007/001336 and WO2008/056349) in at least the following locations: page 2, lines 12–17; page 5, lines 15–16; page 5, line 27 to page 6, line 27; page 8, line 29 to page 9, line 6; page 9, lines 22–30; page 10, lines 25–26; and page 11, lines 16–28. Additional support may be found in at least U.S. Pat. Provisional App. No. 60/856,795 at least at pages 2–3.

D. Response to All Grounds of Unpatentability

As detailed above, substitute independent Claim 25 recites limitations narrowing the subject matter of challenged Claim 17, which has been rewritten in independent form. As explained above, the references in this IPR do not disclose each and every limitation of substitute independent Claim 25. As substitute dependent Claims 26–29 recite additional patentable subject matter, the references in this IPR also fail to disclose each and every limitation of substitute Claims 26–

29. Accordingly, Petitioners have failed to make a prima facie case of obviousness with respect to substitute Claims 26–29.

IV. **Conclusion**

Patent Owner respectfully requests the Board grant this Motion to Amend should it find that a preponderance of the evidence establishes that any of Claims 15 and/or 17–22 are unpatentable.

Date: November 20, 2018

Respectfully submitted,

By: /s/_____

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), we certify that this Motion to Amend complies with the page limitation of 37 C.F.R. § 42.24(a)(vi) because it contains fewer than the limit of 25 pages, as determined by the word-processing program used to prepare the Motion to Amend, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S MOTION TO AMEND PURSUANT TO 37 C.F.R. § 42.121 together with any accompanying exhibits are being filed via PTAB E2E and served by electronic mail this 20th day of November 2018 on counsel for Petitioners as follows:

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